

REMARKS/ARGUMENTS

The Office Action of June 9, 2004 has been carefully reviewed and this response addresses Examiner's concerns stated in the Office Action.

Claims 1-19 and 21-29 are currently pending in the application. Claims 1, 2, 7, 8, 10, 12, 14, 16, 18, and 19 have been amended to clarify terminology and to further define the invention. Claim 20 has been cancelled without prejudice. Claims 21-29 have been added to further define the invention.

A Petition for a one-month extension and an extension fee of \$110 for a large entity is attached hereto. Applicants note that, under 37 C.F.R. § 1.7(a), since October 9, 2004, the date upon which the response and extension fee were due, fell on a Saturday, and since the following Monday, October 11, 2004, was a federal holiday, the response to this Office Action is being timely filed on October 12, 2004.

On page 2, paragraphs 1-2 of the Office Action, claim 18 is rejected under 35 U.S.C. §102(b) as being anticipated by Petrovich et al., United States Pat. No. 6,101,483, issued August 8, 2000 (Petrovich).

Applicants have amended independent claim 18 to further define the invention as follows:

Claim 18: (currently amended) A method for using a purchasing aid logistics appliance, comprising the steps of:

downloading product data from a web site ~~or bar-coded advertisement;~~
creating a shopping list from the product data;
transmitting the shopping list to a merchant computer upon entry into a merchant facility;
receiving product data from the merchant computer upon entry into the merchant facility;

scanning a product bar code when a product is removed from the shelf and placed in a shopping cart for purchase;
creating a shopping cart file when the product is scanned; and
transmitting the shopping cart file to the merchant computer to checkout.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments which are ~~struck through~~. To further Applicants' position of the patentability of amended independent claim 18, Applicants note the following.

(1) Examiner states that Petrovich discloses a method for using a purchasing aid logistics appliance (40) comprising

downloading product data from a web site or bar coded advertisement,
creating a shopping list from said product data,
transmitting said shopping list to a merchant computer upon entry into a merchant facility (24 linked to 16),
receiving product data from said merchant computer upon entry into said merchant facility (col. 7, lines 18-27),
scanning a product bar code when a product is removed from the shelf and placed in a shopping cart for purchase (col. 12, lines 35-36),
creating a shopping cart file when said product is scanned (col. 12, lines 36-40),
and
transmitting said shopping cart file to said merchant computer to checkout (col. 12, lines 49-57).

(2) Examiner states that the hard copy of the shopping list described in col. 7, lines 18-27, inherently includes product data, as a way to identify the product.

As a rebuttal to Examiner's position, Applicants respectfully point out that Examiner has not provided a Petrovich citation for the step of downloading product data from a web site. Applicants have reviewed Petrovich and could not find an expressed or inherent disclosure or teaching in Petrovich to the above mentioned recited step of independent claim 18. On the contrary, Petrovich discloses downloads from (1) the portable terminal to the host computer when the portable terminal is in the shopping establishment's kiosk cradle (col. 2, lines 28-35), and (2) the host computer to the portable terminal when the user is traversing the shopping establishment so that the user can locate the desired goods (col. 10, lines 47-51). Petrovich discloses Internet access (col. 4, line 4) to connect the host computer to other components of the system within the shopping establishment. Nowhere does Petrovich disclose downloading product data from a web site.

Since it appears that Petrovich does not set forth each and every element of Applicants' independent claim 18, either expressly or inherently, Applicants' independent claim 18 is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §102(b) with regards to independent claim 18 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations.

On pages 2-4, paragraphs 3-11 of the Office Action, claims 1, 4, 5, 9, 11, 13, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Ruppert et al., United States Pat. No. 5,424,524 (Ruppert).

Applicants have amended independent claim 1 to further define the invention as follows:

Claim 1: (currently amended) A portable 2-way secure purchasing aid logistics appliance, comprising:

means for inputting information;
a central processor coupled to said means for inputting information to generate a shopping list, wherein said central processor includes application software to maintain a budget and to perform finance computations and to track financial accounts;
means for providing secure memory coupled to said central processor to safeguard personal and financial information;
means for outputting said shopping list, and said personal and said financial information; and
a display to view said shopping list.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments which are underlined. To further Applicants' position of the patentability of amended independent claim 1 (and dependent claims 2-17 and 25 that depend, directly or indirectly, from amended claim 1), Applicants note the following.

With respect to amended independent claim 1, on page 3, in paragraphs 4 and 5 (and in paragraphs 28-29, page 10),:

(1) Examiner states that Petrovich discloses means for securing memory coupled to said central processor to safeguard personal and financial information (col. 4, lines 19-22 and 55-61); also Examiner states that (a) the arguments (of the previous Office Action response) with respect to claims 1-7, 9, 11, 13, 15, 16, and 19 are moot in view of the new grounds of rejection (page 10, paragraphs 27-28 of the Office Action), (b) the limitations of paragraph 47 of Applicants' specification are not present in the claims (page 10, paragraph 28 of the Office Action), and (c)

Applicants' argument appears to be narrower than the claimed limitations (page 10, paragraph 28 of the Office Action).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses providing user permission to navigate within a system that contains accessible information as follows: (1) an optional initialization procedure for entering an appropriate code for security and identification purposes (col. 5, lines 19-22), (2) a PIN or credit card means for identification and safeguard of portable terminal 40 (col. 5, lines 55-61)), and (3) a code burned into circuitry, or set by dip switches or any other convenient manner (col. 5, lines 45-52), Contrary thereto, Applicants claim a means for providing secure memory (a term of art), i.e. a means for making the information itself unusable even if it is accessed. To provide an analogy, if Petrovich's user permission granting is equivalent to providing a key to locked room, Applicants' means for providing secure memory is equivalent to making the contents in the locked room unusable without authorized access. In general, secure memory is memory that has been, for example, modified in a way that can be reversed with appropriate authentications.

Applicants respectfully note that Petrovich discloses what is known in the art as access control, while Applicants, on the contrary, claim a means for providing secure memory, which is clearly distinct from access control. Access control does not involve any sort of modification, but instead involves authentication checks against pre-stored values, for example, a processor mode or a password. One form of access control is seen in CPU instructions that may only be executed in supervisor mode. The division of virtual memory into kernel and user parts is also a form of access control. For information related to access control and secure memory, see <http://www.kernelthread.com/publications/security/ac.html>. In contrast to access control, Applicants claim a means to provide secure memory.

(2) Examiner further states that Petrovich fails to disclose the central processor to include application software to maintain a budget and to perform finance computations.

(3) Examiner still further states that Ruppert, which Examiner relies upon to meet some of the patentable features of Applicants' claimed invention, teaches a personal scanner device to aid shoppers, where the scanner device maintains a budget (26) and performs finance computations (calculates running total), aiding shoppers in keeping track of their expenditures (Abstract).

Applicants respectfully point out that performing finance computations and tracking financial accounts involve managing financial information, such as recording financial transaction logs in parallel with banks (see Applicants' specification, page 6, paragraph 27) that is of such a nature that layers of security can be required (see Applicants' specification, page 14, paragraph 43). Applicants' claimed finance computations and tracking financial accounts are clearly different from Ruppert's arithmetic comparison of a running total with a user-specified numerical upper limit (budget). Further, Applicants respectfully point out that Ruppert does not make clear how the price of an item that is somehow determined by the system of Ruppert is correlated with the actual price at checkout. Applicants respectfully point out that it is not clear then how Ruppert can maintain a budget without knowing the actual price of the item at checkout.

(4) Even further Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by Ruppert, such that the central processor of Petrovich's appliance maintains a budget and performs finance computations, in order to aid shoppers in keeping track of their expenditures.

Applicants respectfully point out that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to

make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Applicants respectfully refer Examiner to amended independent claim 1. Applicants have clarified, in amended independent claim 1, that Applicants' central processor includes application software to maintain a budget and to perform finance computations and tracking financial accounts. Neither Petrovich nor Ruppert disclose tracking financial accounts, nor do their systems provide enough security to support tracking financial accounts. Applicants', on the other hand, provide enhanced security measures to protect the financial accounts, in particular, secure memory, specifically provided for in independent claim 1, in which to store the financial accounts. Further, the teaching or suggestion to make a means for providing secure memory in order to safeguard personal and financial information and the reasonable expectation of success are not found in the prior art. Applicants respectfully point out that neither Petrovich nor Ruppert discloses financial security as in Applicants' invention and thus it is clear to one skilled in the art that neither Petrovich nor Ruppert is intended to perform finance computations and track financial accounts.

Applicants respectfully point out that since Petrovich and Ruppert, separately or in combination, do not teach or suggest each and every element of Applicants' independent claim 1, either expressly or inherently, Applicants' independent claim 1 (as well as dependent claims 2-17 and 25 that depend directly or indirectly therefrom and that further define the invention) is not made obvious by Petrovich and Ruppert, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent claim 1 (as well as dependent claims 2-17 and

25 that depend directly or indirectly therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to dependent claims 2-17 for the reasons set forth above.

Further remarks with regard to the patentable distinctions of Applicants' claimed invention over Petrovich in view of Ruppert are provided below.

With respect to dependent claim 5, on page 4, in paragraph 7, Examiner states that Petrovich and Ruppert disclose the central processor to compare the shopping list to said bar code signals to determine whether product is a new product to add to said shopping list or an existing product (col. 10, lines 1-18), whereby said central processor tracks the total cost of products scanned, the remaining products to be scanned, and the available funds remaining in the budget. Applicants respectfully point out that neither Petrovich nor Ruppert discloses that a central processor tracks the available funds remaining in the budget. Ruppert describes allowing the user to enter a budget number (col. 2, lines 26-28), but nowhere does Ruppert describe tracking the available funds remaining in the budget. Ruppert simply presents the budget number (that had previously been entered by the user) and the total expenditures (see FIGs. 1 and 13, ref. nums. 26 and 22).

Applicants respectfully point out that, since Petrovich and Ruppert do not teach or suggest each and every element of Applicants' dependent claim 5, either expressly or inherently, Applicants' dependent claim 5 is not made obvious by Petrovich and Ruppert and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claim 5 and find dependent claim 5 in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of independent claim 1, from which dependent claim 5 depends, and therefore Applicants assert that dependent claim 5 is in condition for allowance.

With respect to dependent claims 4, 9, 11, 13, and 15, on pages 3 and 4, paragraphs 6 and 8-11, Applicants respectfully request that Examiner withdraw the rejections under 35 U.S.C. § 103(a) directed to dependent claims 4, 9, 11, 13, and 15 and find dependent claims 4, 9, 11, 13, and 15 in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of independent claim 1, from which dependent claims 4, 9, 11, 13, and 15 depend, either directly or indirectly, and therefore independent claim 1, as well as dependent claims 4, 9, 11, 13, and 15, are in condition for allowance.

On pages 4-6, paragraphs 12-17 of the Office Action, dependent claims 2, 3, 8, 12, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Petrovich in view of Ruppert, and in further view of WIPO Patent Publication No. WO 01/20526 (WO '526).

Applicants respectfully point out that Examiner's cited reference, WO '526, published on March 22, 2001, was published within one year of the filing date of the present application, January 4, 2002. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind the WO '526 reference.

Applicants have amended dependent claim 2 to further define the invention as follows:

Claim 2: (currently amended) The portable 2-way secure purchasing aid logistics appliance according to claim 1 further comprising:

a plurality of antennas capable of enabling non-interfering and secure communications between the purchasing aid logistics appliance and a merchant's computer for a plurality of simultaneous signals, the merchant's computer capable of enabling each of said plurality of antennas independently based on the location of the purchasing aid logistics appliance with respect to said plurality of antennas,

wherein said means for inputting information is a radio receiver capable of receiving signals based on the location of said radio receiver with respect to said plurality of antennas, from a radio transmitter coupled to the merchant computer through said plurality of antennas, wherein the merchant computer transmits product information in response to a signal by said purchasing aid logistics appliance for product information.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to Applicants' amendments which are underlined. To further Applicants' position of the patentability of amended dependent claim 2, Applicants note the following.

With respect to dependent claim 2, on pages 4-5, in paragraphs 12-13,

(1) Examiner states that neither Petrovich nor Ruppert disclose the means for inputting information to be a radio receiver that receives signals from a radio transmitter coupled to a merchant computer or an internet port that is connectable to a personal computer linked to a merchant web site.

(2) Examiner states that WO '526 teaches a shopping list organizer comprising a portable device (112) where information may be input to the portable device (112) by a radio receiver or an internet port, WO '526 describes inputting information by placing the portable device (112) in a "cradle" (page 15, line 29), WO '526 recites that instead of a cradle, the portable device may

communicate with an in store computer by radio (page 18, lines 26-29), and a radio receiver and transmitter as claimed must be included in this arrangement described by WO '526 in order to facilitate the radio communication.

Applicants respectfully point out that WO '526 does not disclose Applicants' claimed radio receiver capable of receiving signals based on the location of said radio receiver with respect to the plurality of antennas. Applicants respectfully note also that the wireless connection recited by WO '526 is merely a statement of fact, and that fact alone cannot be used to render the specifics of Applicants' claimed invention unpatentable..

(3) Examiner states that inputting information by radio transmission reduces hardware costs by eliminating peripheral components, such as cradles, it also allows for a greater flexibility in the location of the user, and it would have been obvious to one skilled in the art to modify Petrovich and Ruppert, such that the means for inputting information is a radio receiver, to reduce peripheral hardware costs and allow flexibility in the location of the user.

Applicants respectfully point out that it is not obvious how wireless activity would be handled in terms of both interference and security issues, as Applicants have shown (see Specification, paragraphs 55 and 56). Thus, the mere mention of wireless transmissions in WO '526 does not create an appropriate teaching to negate the patentability of Applicants' claimed invention. Applicants respectfully point out that since Petrovich, Ruppert, and WO '526, either separately or in combination, do not teach or suggest each and every element of Applicants' dependent claim 2, either expressly or inherently, Applicants' dependent claim 2 is not made obvious by Petrovich, Ruppert, and WO '526, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claim 2 and find dependent claim 2 in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of

independent claim 1, from which dependent claim 2 depends, and therefore Applicants assert that dependent claim 2 is in condition for allowance.

With respect to dependent claim 3, on pages 5-6, in paragraph 14, Examiner states that the portable device taught by WO '526 may be coupled to a desktop computer where it can be configured to download information from a merchant web site ("various sites", page 11, line 25), this process is described on page 11, lines 19-26, and the device used to couple the portable device (112) to the desktop computer is considered to be the internet port. Examiner further states that the device used to couple the portable device (112) to the desktop computer is considered to be the internet port, and though the device is not described, it is inherent based on the disclosure of the system in WO '526, and that inputting information via an internet port allows the user to input information into the portable device while at home, and does not require the user to have any extra bar codes or codes present in order to enter an item to a list, and it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich and Ruppert as taught by WO '526 such that means for inputting information includes an internet port, so the user may add items to a list while at home, without having any other product information available, such as a bar code.

With respect to dependent claim 8, on page 6, in paragraph 15, Examiner states that neither Petrovich nor Ruppert discloses inputting information with a keypad, and that it is well known in the art to use a keypad to inter information, as taught by WO '526, keypads are commonly used to input information when bar code readers or magnetic card reads fail, and it would have been obvious to one skilled in the art to input information in the combination of Petrovich and Ruppert by using a keypad as shown by WO '526.

Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claims 3 and 8 and find dependent claims 3 and 8 in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of

independent claim 1, from which dependent claims 3 and 8 depend, and therefore Applicants assert that dependent claims 3 and 8 is in condition for allowance.

Applicants have amended dependent claims 12 and 14 as follows:

Claim 12 (currently amended): The portable 2-way secure purchasing aid logistics appliance according to claim 11 wherein said first signal comprises a credit card number and personal identification number, said personal identification number capable of being a basis for unlocking said secure memory.

Claim 14 (currently amended): The portable 2-way secure purchasing aid logistics appliance according to claim 11 wherein said first signal comprises a debit card number and personal identification number, said personal identification number capable of being a basis for unlocking said secure memory.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to Applicants' amendments which are underlined. To further Applicants' position of the patentability of amended dependent claims 12 and 14, Applicants note the following.

With respect to dependent claims 12 and 14, on page 6, in paragraphs 16-17,:

(1) Examiner states that neither Petrovich nor Ruppert discloses the first signal to comprise a credit or debit card number and personal identification number.

(2) Examiner states that WO '526 teaches a method of electronic payment where either credit card or debit card numbers (page 16, lines 19-20) and a PIN number ("customer identification number") are transmitted to a merchant computer.

Applicants respectfully point out that WO '526 does not disclose Applicants' claimed personal identification number capable of being a basis for unlocking said secure memory.

(3) Examiner states that Applicants have not provided any criticality for the credit or debit card information, along with a PIN number, to be the first signal, rather than the shopping list; transmitting the customer's payment data before the shopping list appears to be a design choice, as no new or unexpected result arises from such a transaction.

Applicants claim a means for providing secure memory, which is described to be implemented, for example, such that sequential logical memory address locations are physically encrypted according to the algorithm of FIGs. 9, 10 and 11 in Applicants' specification. As Applicants describe, Applicants' claimed personal identification number becomes part of an encoding variable that encrypts the translation of physical address to logical address, and visa versa, thus making it necessary, when secure memory is used, to have a first signal comprising a personal identification number in order to be able to take the step of decrypting memory before proceeding to process other incoming information.

(4) Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Petrovich and Ruppert as taught by WO '526, such that either a credit card number or debit card number, along with a PIN number is the first signal transmitted to a merchant computer, as a matter of design choice.

Applicants respectfully point out that an "examiner's unsupported, conclusionary, statement regarding obvious design choice is not a substitute for evidence". *Ex parte T. Yamakawa et al.*, Appeal # 2002-2082, Appl. # 09/289,393, 8/21/2003, BPAI (Examiner did not point to any teaching or suggestion in the prior art that would have suggested having no holes upstream of a heater element). Applicants further respectfully point out that "the PTO erred in rejecting the claimed invention as a mere 'design choice' modification of prior art when the applicant presented evidence of technical problems in the prior art that would have deterred one from making the modification." *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995).

Applicants respectfully point out that Examiner has provided no evidence that would make Applicants' first signal an obvious design choice since Petrovich, Ruppert, and WO '526, either singly or in combination, do not teach or suggest encrypting or decrypting of secure memory. Applicants' dependent claims 12 and 14 are not made obvious by Petrovich, Ruppert, and WO '526 and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claims 12 and 14 and find dependent claims 12-14 in condition for allowance. As stated above, Petrovich, Ruppert, and WO '526 do not substantially teach the limitations of independent claim 1, from which dependent claims 12 and 14 indirectly depend, and therefore Applicants assert that dependent claims 12 and 14 are in condition for allowance.

On pages 7-8, in paragraphs 18-20 of the Office Action, dependent claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Ruppert, and in further view of Shaw, United States Pat. No. 6,568596 (Shaw).

Applicants respectfully point out that Examiner's cited reference, Shaw, issued on May 27, 2003, was published after the filing date of the present application, January 4, 2002. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind the WO '526 reference.

With respect to dependent claims 6 and 7, on page 7, in paragraphs 18 and 19,:

(1) Examiner states that neither Petrovich nor Ruppert disclose the central processor to include software that converts the bar code signals into a web page to be displayed on the display.

(2) Examiner states that Shaw teaches a method where a bar code is converted into a web page (col. 3, line 51 to col. 4, line 6) and displayed.

Applicants respectfully point out that the method of Shaw scans bar codes, uses data type definition files or XML schema to relate the bar codes to XML, creates an XML document, and transfers the XML document to another computer for display. Applicants assert that Shaw does not disclose a direct relationship between the bar code and the display. Contrary thereto, Applicants claim a central processor in the purchasing aid logistics appliance that includes executable software to decode bar code signals that contain one of a plurality of computer languages that can be parsed to produce a web page. The web page is displayed directly on the purchasing aid logistics appliance. Shaw discloses no such capability embedding elements of one of a plurality of computer languages in a bar code, and, after decoding the bar code, of displaying a web page on a purchasing aid logistics appliance display using the decoded bar code.

(3) Examiner states that this method allows information to be published in near real time, as the scanned information is already in a markup language, and this also eliminates discrete states of data collection and data manipulation before publication (col.1, lines 9-13), and it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich and Ruppert as taught by Shaw such that central processor includes software to convert bar codes into a web page because this allows for quicker publication of a scanned item.

Applicants respectfully point out that (1) Examiner has stated that neither Petrovich nor Ruppert disclose the central processor to include software that converts the bar code signals into a web page to be displayed on the display and (2) Applicants have shown that Shaw discloses no such capability of displaying a web page on a purchasing aid logistics appliance display. Applicants respectfully point out that since Petrovich, Ruppert, and Shaw, either singly or in combination, do not teach or suggest each and every element of Applicants' dependent claim 6, either expressly or inherently, Applicants' dependent claim 6 (and dependent claim 7 which depends upon dependent claim 6) is not made obvious by Petrovich, Ruppert, and Shaw and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that

Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claim 6 and find dependent claim 6 (and dependent claim 7 which depends upon dependent claim 6) in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of independent claim 1, from which dependent claim 6 depends, and therefore Applicants assert that dependent claim 6 (and dependent claim 7 which depends upon dependent claim 6) is in condition for allowance.

Applicants have amended dependent claim 7 to further define the invention as follows:

Claim 7: (currently amended) The portable 2-way secure purchasing aid logistics appliance according to claim 6 wherein said executable software includes:

a bar code capable of representing a display in one of a plurality of computer languages;
a decoder having at least one decode table, said decoder capable of interpreting the one of a plurality of computer languages according to the at least one decode table to provide parsing information;

a parser capable of creating display executable code to build the display from said parsing information; and

a display browser capable of creating a web page from said display executable code.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to Applicants' amendments which are underlined. To further Applicants' position of the patentability of amended dependent claim 7, Applicants note the following.

With respect to dependent claim 7, on page 7, in paragraph 20,

(1) Examiner states that Shaw discloses only the use of XML, but states that "any other suitable markup language may also be used" (col. 2, line 14).

Applicants respectfully point out that Shaw discloses the use of a single language, whereas Applicants claim a decoder capable of converting bar code signals into any one of a plurality of computer languages. Nowhere does Shaw disclose Applicants' additional multi-step process designed to make, for example, the vertical bar code format or similar code independent of any browser language (Applicants' Specification, paragraph 34, page 10).

(2) Examiner states that an XML decoder, and a parser having a modifying table are inherent in Shaw's invention, as they must be present to decode the markup language and construct frame software, a display browser is also inherent in Shaw, and that the bar code containing the XML script can be converted into a web page.

Applicants respectfully point out that the general rule of inherency may be relied upon only where the consequences of following the reference disclosure always inherently produces or results in the claimed invention. *W.L. Gore Associates, Inc. v. Garlock Inc.*, 220 U.S.P.Q. 303, 314. If there is not a reasonable certainty that the claimed subject matter will necessarily result, the rejections fails. *In re Brink*, 164 USPQ 247. Also, accidental results, not intended and not anticipated, do not constitute an anticipation. *Georgia-Pacific Corp. v. United States Plywood Corp.*, 118 USPQ 122, 128. MPEP § 2112 (page 2100-53, May 2004) states that to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicants respectfully point out Shaw does not disclose or suggest a decoder that can determine a selected language from a plurality of computer languages, and can convert bar code

signals into the selected language. There is no basis in fact and/or technical reasoning to reasonably support the determination that Applicants' decoder necessarily flows from the teachings of the Shaw.

(3) Examiner states that Shaw does not explicitly provide the decoder to have HTML, JAVA, and WAP decode tables, or that HTML, JAVA, or WAP script can be converted into a web page.

(4) Examiner states that because the use of HTML, JAVA, WAP, and XML are all well known in the art to create web sites, Official Notice is taken that HTML, JAVA, and WAP script may be substituted for the XML script of Shaw.

Applicants respectfully rebut the Official Notice taken that Applicants' HTML, JAVA, and WAP script may be substituted for the XML script of Shaw. Applicants respectfully point out that, "[O]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP § 2144.03 A. Applicants herein respectfully traverse Examiner's Official Notice.

Applicants respectfully point out that since Shaw does not disclose a multi-step process for determining a selected language, Applicants assert that one skilled in the art would not be able to instantly demonstrate Applicants' decoder from the disclosure of Shaw as to defy dispute.

(5) Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Petrovich, Ruppert, and Shaw such that the bar codes of Shaw may contain HTML, JAVA, or WAP script, and the decoder has

HTML, JAVA and WAP decode tables. Applicants respectfully point out that since the combination of Petrovich, Ruppert, and Shaw, either singly or in combination, do not teach or suggest each and every element of Applicants' amended dependent claim 7, either expressly or inherently, Applicants' amended dependent claim 7 is not made obvious by Petrovich, Ruppert, and Shaw and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that Applicants' amended dependent claim 7 is now in condition for allowance. Therefore, Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to amended dependent claim 7 for the reasons set forth above. As stated above, Petrovich, Ruppert, and Shaw do not substantially teach the limitations of dependent claim 6, from which amended dependent claim 7 depends, and therefore Applicants assert that amended dependent claim 7 is in condition for allowance.

On pages 8-9, paragraphs 21-23 of the Office Action, dependent claims 10, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Ruppert as applied to independent claim 1, and in further view of Ogasawara, United States Pat. No. 6,123,259, issued on September 26, 2000 (Ogasawara).

Applicants have amended dependent claim 10 to further define the invention as follows:

Claim 10 (original): The portable 2-way secure purchasing aid logistics appliance according to claim 1 wherein said means for providing secure memory includes a smart card reader and encryption circuitry.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to this amendment. To further Applicants' position of the patentability of amended dependent claim 10, Applicants respectfully note the following.

With respect to dependent claims 10 and 17, on page 8, in paragraphs 21 and 22,:

(1) Examiner states that neither Petrovich nor Ruppert disclose a smart card reader and a smart card storing a user personal identification number.

(2) Examiner states that Ogasawara teaches a portable shopping device that interfaces with a smart card (col. 6, lines 12-36), and that contains pertinent user data, and by using a smart card, the user data are secured and access to personal data is limited.

Applicants respectfully point out that none of Petrovich nor Ruppert nor Ogasawara teach or suggest a means for providing secure memory that includes a smart card and encryption circuitry. The smart card of Ogasawara is a means for transporting personal data from place to place which can be programmed or reprogrammed using the read/write circuitry of the card interface (col. 6, lines 34-36). Nowhere does Ogasawara disclose encryption circuitry nor secure memory.

(3) Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petrovich and Ruppert as taught by Ogasawara in order to limit access to personal information.

Applicants respectfully point out that since Petrovich, Ruppert and Ogasawara, either singly or in combination, do not teach or suggest each and every element of Applicants' dependent claim 10, either expressly or inherently, Applicants' dependent claim 10 (and dependent claim 17 which depends from dependent claim 10) is not made obvious by Petrovich, Ruppert and Ogasawara and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claim 10 and find dependent claim 10 (and dependent claim 17 which depends from dependent claim 10) in condition for allowance. As stated above, Petrovich, Ruppert and Ogasawara do not substantially teach the limitations of independent claim 1, from which dependent claim 10 (and dependent claim 17 which depends from dependent claim 10) depends, and therefore Applicants assert that dependent claims 10 and 17 are in condition for allowance.

Applicants have amended dependent claim 16 to further define the invention as follows:

Claim 16 (currently amended): The portable 2-way secure purchasing aid logistics appliance according to claim 15 wherein said means for outputting controls signal strength to communicate with a merchant sales register to minimize the possibility of transmission interception during a purchase transaction.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to this amendment. To further Applicants' position of the patentability of amended dependent claim 16, Applicants respectfully note the following.

With respect to dependent claim 16, on page 8, in paragraph 23,:

(1) Examiner states that Petrovich and Ruppert fail to disclose the means for outputting to control signal strength to minimize the possibility of transmission interception.

(2) Examiner states that Ogasawara teaches a portable shopping device that communicates with an external information source terminal by a wireless communication transceiver, the radio frequency is controlled from about 900 MHz to 2.4 GHz (col. 5, lines 19 - 42), Ogasawara discloses the claimed structure, and for this reason is capable of performing the claimed function, Ogasawara discloses the radio signal strength to be controlled when communicating with another terminal, or merchant sales register, as claimed, because Ogasawara's signal strength is controlled, it is capable of minimizing the possibility of transmission interception.

Applicants respectfully point out that Ogasawara discloses a personal shopping system that assists a shopper during the shopping process. However, Ogasawara does not disclose minimizing the possibility of transmission interception during a purchase transaction. Ogasawara does not disclose any part of a purchase transaction.

(3) Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich and Ruppert as taught by Ogasawara in order to minimize the possibility of transmission interception.

Applicants respectfully point out that since Petrovich, Ruppert, and Ogasawara, either singly or in combination, do not teach or suggest each and every element of Applicants' dependent claim 16, either expressly or inherently, Applicants' dependent claim 16 is not made obvious by Petrovich, Ruppert, and Ogasawara and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claim 16 and find dependent claim 16 in condition for allowance. As stated above, Petrovich and Ruppert do not substantially teach the limitations of independent claims 1 and dependent claim 15, from which dependent claim 16 depends, and therefore Applicants assert that dependent claim 16 is in condition for allowance.

On pages 9-10, paragraphs 24-26 of the Office Action, independent claim 19 and dependent claim 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of WO '526 and Ruppert.

Applicants have cancelled dependent claim 20 without prejudice and have amended independent claim 19 to further define the invention as follows:

Claim 19 (currently amended): A purchasing aid logistics appliance comprising,
means for creating a shopping list outside a merchant facility;
means for storing said shopping list and user personal information in secure memory;
means for automatically uploading said shopping list to a merchant computer upon entry into said merchant facility;
means for two-way data and voice communication with said merchant computer;
means for displaying said shopping list;

means for optically inputting product information data;
means for electronic payment; and
means for calculating total price of items selected.

Applicants respectfully request Examiner to reconsider the rejection in light of this amendment. To further Applicants' position of the patentability of amended claim 19, Applicants respectfully note the following.

With respect to independent claim 19 and dependent claim 20, on page 9, in paragraphs 24-25,:

(1) Examiner states that Petrovich discloses means for storing said shopping list and user personal information (16, 40).

Applicants respectfully point out that Petrovich does not disclose storing said shopping list and user personal information in secure memory.

(2) Examiner states that Petrovich does not disclose means for electronic payment or means for calculating the total price of the items, as claimed.

(3) Examiner states that WO '526 teaches a shopping list organizer comprising a portable device (112) that includes means for making an electronic payment (page 16, lines 8-31), electronic payments allow for payments to be made more quickly, and do not require the user to carry any additional method of payment, and it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by WO '526, in order to make quicker payments, and allow the user to make payments without carrying any additional payment devices.

Applicants respectfully disagree with Examiner that WO '526 makes electronic payment through a PDA obvious to one skilled in the art. In particular, WO '526 recites several means for

electronic payment, none of which describe both the process by which a typical merchant accepts electronic payment. For example, WO ‘526 recites the manual entry of credit card information from the PDA display to the merchant sales register by the merchant’s employee, but does not mention how the PDA information could be verified by the merchant’s employee, a process that is normally manually managed by a review of the signature on the reverse of the credit card. A means for electronic payment includes all steps in the process, not simply the entry of a credit card number. In another example, WO ‘526 recites a temporary identification number stored in the PDA, presumably linked to credit card information, that would somehow be accessed and understood by the merchant sales register. Nowhere does WO ‘526 describe these possibilities, which are not conventionally available. Nowhere does WO ‘526 describe how such sensitive information such as a credit card number and possibly electronic signatures would be protected from unauthorized access in the context of a PDA linked to a merchant sales register in a shopping establishment.

(4) With further respect to independent claim 19 and dependent claim 20, on pages 9-10, in paragraphs 24-26, Examiner also states that Petrovich discloses a purchasing aid logistics appliance (40) comprising means for creating a shopping list outside a merchant facility (32, 16), means for automatically uploading said shopping list to a merchant computer upon entry into said merchant facility (24) and means for two-way data and voice communication (col. 12, lines 9-27) with said merchant computer. (In paragraph 30 of the Office Action, Examiner notes that “automatic” is considered broadly, in the sense that the user in Petrovich is not manually uploading the shopping list to the merchant computer’s database, but that this process is carried out by the computers. Examiner states that whether or not a user initiates the uploading process is not part of the uploading process.) Returning to paragraph 24, Examiner states that Petrovich also discloses means for displaying said shopping list (72), and means for optically inputting product information data (bar code reader), and that, with respect to dependent claim 20, the means for storing is secure. In paragraph 26, Examiner further states that Ruppert teaches a

personal scanner device to aid shoppers, where the scanner device includes means for calculating the total price of the items (Abstract). Examiner states that these features aid shoppers in keeping track of their expenditures (Abstract).

Applicants respectfully point out that Petrovich does not disclose any type of storing into secure memory.

(5) Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by Ruppert, such that the central processor of Petrovich's appliance maintains a budget and performs finance computations, in order to aid shoppers in keeping track of their expenditures.

Applicants respectfully point out that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Since Petrovich, Ruppert, and WO '526, separately or in combination, do not teach or suggest each and every element of Applicants' independent claim 19, either expressly or inherently, Applicants' independent claim 19 is not made obvious by Petrovich, Ruppert, and WO '526, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent claim 19 is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to independent claim 19 for the reasons set forth above.

In view of the absence from any cited reference of Applicants' claimed invention as set forth above, Applicants respectfully urge that Petrovich, Ruppert, WO '526, Shaw, Ogasawara, Official Notice, and inherency, separately or in combination, are legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103.

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Amdt. Dated October 12, 2004
Reply to Office Action of June 9, 2004
Docket No.: 12078-129

Claims 21-29 have been added to further define the invention. Independent claims 1, 19 and 21, 22, 26, 27, 28, and 29 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance.

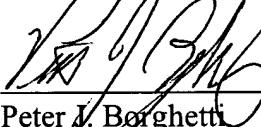
Enclosed herein is a petition for a one-month extension of time and the appropriate fee (\$110) for a large entity. Eight additional claims have been added beyond the claims originally paid for (\$144), including six additional independent claims (\$528). A check for \$782 is enclosed herein. The Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-129.

The following information is presented in the event that a call may be deemed desirable by the Examiner: PETER J. BORGHETTI (617) 854-4000.

Respectfully submitted,
Joseph Claude Caci et al., Applicants

Date: October 12, 2004

By:


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